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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/670,849

**Applicant(s)**

SHAH, RAHUL L.

**Examiner**

JOSHUA JOO

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-57 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

***Detailed Action***

1. This Office action is in response to the communication dated 01/29/2008.

Claims 1-57 are presented for examination.

**Examiner's Note**

2. In view of the Appeal Brief filed on 01/29/2008, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

**Specification**

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Regarding claims 20-38, the term "computer-accessible storage medium" lacks sufficient antecedent basis in the specification. The specification describes of "mass storage device" and "computer-accessible medium include storage media or memory media... computer-accessible medium may also include volatile or non-volatile media..." (page 23, paragraph 0056; page 25, paragraph 0061). Applicant is required to make appropriate amendments to the description to provide clear support for the

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term such that the "computer-accessible storage medium" clearly refers to the physical memory media, i.e. storage media.

### Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 20, 30, 39, and 49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 13, 15, 27-29, 41-42 of copending Application No. 10/670550.

Instant Application Claim 1	Copending application #10/670550 Claim 1
A computer-implemented method, comprising: <u>receiving an instant messaging operation directed to a given user, said given user is not offline;</u>	A method, comprising: detecting a computer system activity level indicative of computer system activity;
<u>determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and</u>	determining whether said activity level exceeds an activity threshold in response to said detecting; and
<u>selectively processing said instant messaging operation dependent upon said presence state in response to said determining</u>	transitioning a presence state of an instant messenger to a busy state in response to determining that said activity level exceeds said

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	activity threshold, <u>wherein said presence state corresponds to a given user.</u>
	<b>Claim 13</b>
	The method as recited in claim 1, further comprising:
	<u>receiving an instant messaging operation directed to a given user, wherein said given user is not offline;</u>
	<u>determining said presence state of said instant messenger in response to receiving said instant messaging operation; and</u>
	<u>selectively processing said instant messaging operation dependent upon said presence state in response to said determining.</u>

<b>Instant Application Claim 30</b>	<b>Copending application #10/670550 Claim 15</b>
A computer-accessible storage medium, comprising program instructions, wherein the program instructions are computer-executable to: <u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user;</u>	A computer-accessible medium comprising program instructions, wherein the program instructions are computer-executable to: detecting a computer system activity level indicative of computer system activity;
<u>detect a transition to said given presence state subsequent to said storing; and</u>	determining whether said activity level exceeds an activity threshold in response to said detecting; and
<u>perform said instant messaging operation in response to said detecting.</u>	transitioning a presence state of an instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold, wherein said presence state corresponds to a given user.
	<b>Claim 28</b>
	The computer-accessible medium as recited in claim 15, wherein said program instructions are further computer-executable to:
	<u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user;</u>
	<u>detect a transition to said given presence state subsequent to said storing; and</u>
	<u>perform said instant messaging operation in response to said detecting.</u>

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6. Although the conflicting claims are not identical, they are not patentably distinct from each other because: i) claims 1 and 13 of the copending application anticipates claim 1 of the instant application; ii) claims 15, 27, 29 and 41 of the copending application comprise similar features of claims 1 and 13 of the copending application and anticipates claims 20 and 39 of the instant application; iii) claims 15 and 28 of the copending application anticipates claim 30 of the instant application; and iv) claims 29 and 42 of the copending application comprise similar features of claim 15 and 28 of the copending application and anticipates claim 49 of the instant application.

7. Claim 11 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 14 of copending Application No. 10/670550, in view of Chesnais et al. US Patent #7,272,662 (Chesnais hereinafter).

Instant Application Claim 11	Copending application #10/670550 Claim 1
A computer-implemented method, comprising: <u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user;</u>	A method, comprising: detecting a computer system activity level indicative of computer system activity;
<u>detect a transition to said given presence state subsequent to said storing; and</u>	determining whether said activity level exceeds an activity threshold in response to said detecting; and
<u>perform said instant messaging operation in response to said detecting.</u>	transitioning a presence state of an instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold, wherein said presence state corresponds to a given user.
	<b>Claim 14</b> The method as recited in claim 1, further comprising:
	<u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user;</u> <u>detect a transition to said given presence state subsequent to said storing; and</u>

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	<u>perform said instant messaging operation in response to said detecting.</u>
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8. Although the conflicting claims are not identical, they are not patentably distinct from each other because: The copending application discloses common subject matter with the instant application except of the presence state corresponding to an online given user. Chesnais teaches of a presence state corresponding to an online user and detecting a transition from the presence state (col. 5, lines 1-6, 10-17. Change profile. End of "do not disturb."). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the copending application to comprise a presence state corresponding to an online given user, which would improve the method by allowing selective processing of messages based on status and preventing sending of messages that may be disrupted to an online user.

9. Claims 1, 20, 30, 39, and 49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 11, 19-21, 29-30 of copending Application No. 10/670549.

<b>Instant Application Claim 1</b>	<b>Copending application #10/670549 Claim 1</b>
A computer-implemented method, comprising: <u>receiving an instant messaging operation directed to a given user, said given user is not offline;</u>	A method comprising: storing schedule information corresponding to a given user, wherein said schedule information is indicative of an activity status of said given user at a given time;
<u>determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and</u>	querying said schedule information; and
<u>selectively processing said instant messaging operation dependent upon said presence state in response to said determining</u>	if a current presence state of an instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, <u>wherein said current presence state and said different presence state each correspond to said given user.</u>

	<b>Claim 9</b> The method as recited in claim 1, further comprising:
	<u>receiving an instant messaging operation directed to a given user, wherein said given user is not offline;</u>
	determining said presence state of said instant messenger in response to receiving said instant messaging operation; and
	<u>selectively processing said instant messaging operation dependent upon said presence state in response to said determining.</u>

<b>Instant Application Claim 30</b>	<b>Compending application #10/670549 Claim 11</b>
A computer-accessible storage medium, comprising program instructions, wherein the program instructions are computer-executable to: <u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user;</u>	A computer-accessible medium comprising program instructions, wherein the program instructions are computer-executable to: storing schedule information corresponding to a given user, wherein said schedule information is indicative of an activity status of said given user at a given time;
<u>detect a transition to said given presence state subsequent to said storing; and</u>	querying said schedule information; and
<u>perform said instant messaging operation in response to said detecting.</u>	if a current presence state of an instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.
	<b>Claim 20</b> The computer-accessible medium as recited in claim 11, wherein said program instructions are further computer-executable to:
	<u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user;</u>
	<u>detect a transition to said given presence state subsequent to said storing; and</u>
	<u>perform said instant messaging operation in response to said detecting.</u>



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10. Although the conflicting claims are not identical, they are not patentably distinct from each other because: i) claims 1 and 9 of the copending application anticipates claim 1 of the instant application; ii) claims 11, 19, 21, and 29 of the copending application comprise similar features of claims 1 and 9 of the copending application and anticipates claims 20 and 39 of the instant application; iii) claims 11 and 20 of the copending application anticipates claim 30 of the instant application; and iv) claims 21 and 30 of the copending application comprise similar features of claim 11 and 20 of the copending application and anticipates claim 49 of the instant application.

11. Claim 11 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 10 of copending Application No. 10/670549, in view of Chesnais.

Instant Application Claim 11	Copending application #10/670549 Claim 1
A computer-accessible storage medium, comprising program instructions, wherein the program instructions are computer-executable to: <u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user;</u>	A method comprising: storing schedule information corresponding to a given user, wherein said schedule information is indicative of an activity status of said given user at a given time;
<u>detect a transition to said given presence state subsequent to said storing; and</u>	querying said schedule information; and
<u>perform said instant messaging operation in response to said detecting.</u>	if a current presence state of an instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.
	<b>Claim 10</b> The method as recited in claim 1, further comprising:
	<u>store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a</u>

	<u>given user;</u>
	<u>detect a transition to said given presence state</u>
	<u>subsequent to said storing; and</u>
	<u>perform said instant messaging operation in</u>
	<u>response to said detecting.</u>

12. Although the conflicting claims are not identical, they are not patentably distinct from each other because: The copending application discloses common subject matter with the instant application except of the presence state corresponding to an online given user. Chesnais teaches of a presence state corresponding to an online user and detecting a transition from the presence state (col. 5, lines 1-6, 10-17. Change profile. End of “do not disturb.”). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the copending application to comprise a presence state corresponding to an online given user, which would improve the method by allowing selective processing of messages based on status and preventing sending of messages that may be disrupted to an online user.

### **Claim Rejections - 35 USC § 112**

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 10-20, 29-38, 48-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Regarding claim 10, the claim recites, “storing an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to said given user; detecting a transition to said given presence state subsequent to said storing:”. According to the claim, an instant messaging operation associated with a given presence state is stored, and following the storing of the instant message operation, there is a transition to the same given presence state. It is

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unclear as to how there can be a transition to the given presence state when the user is already associated with the given presence state.

The instant specification describes, "IM client 100 may be configured to detect a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state, and in response, to notify the user of queued instant messaging operations... Once the user transitions to an online presence state, queued operations may be delivered for example in the order they were queued" (Paragraph 0094); and "if the present state of the given user is indicative of a busy user state, the received operation may be queued... (Paragraph 0102); "subsequent to queuing of a received operation, a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state may be detected (block 608)" (Paragraph 0103); and "In response to detecting such a transition, the given user may be notified of a queued instant messaging operation (block 610)." (Paragraph 0104) It would appear from the instant specification that an instant messaging operation associated with a state, e.g. a busy state, is stored, and there is a detection of transition to a different state, e.g. idle state and not a transition to the same state, i.e. the given presence state, as indicated by the claim.

Claims 11, 29-30, 48, and 49 comprise features similar to claim 10 and are rejected for the same reasons.

### **Claim Rejections - 35 USC § 102**

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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17. Claims 1-3, 9-15, 18-22, 28-34, 37-41, 47-53, 56-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Chesnais et al. US Patent #7,272,662 (Chesnais hereinafter).

18. As per claims 1 and 20, Chesnais teaches the invention as claimed including a computer-implemented method and a computer-accessible storage medium, comprising:

receiving an instant messaging operation directed to a given user, wherein said given user is not offline (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. col. 5, lines 1-2. Receive messages.);

determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user (col. 5, lines 3-4.

Determine profile, which is set as “do not disturb”.); and

selectively processing said instant messaging operation dependent upon said presence state in response to said determining (col. 13, lines 4-6. Place message in queue.).

19. As per claim 39, Chesnais teaches the invention as claimed including a system, comprising:

a computer system (col. 4, lines 19-21; col. 6, lines 31-34. System to direct messages.

Computing is essential to operating the system.);

an instant messenger software module configured to execute on said computer system (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. Software is essential to perform instant messaging.);

wherein said instant messenger software module is further configured to:

receiving an instant messaging operation directed to a given user, wherein said given user is not offline (col. 5, lines 1-2. Receive messages.);

determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user (col. 5, lines 3-4.

Determine profile, which is set as “do not disturb”.); and

selectively processing said instant messaging operation dependent upon said presence state in response to said determining (col. 13, lines 4-6. Place message in queue.).

20. As per claims 11 and 30, Chesnais teaches the invention as claimed including a method and a computer-accessible storage medium, comprising:

storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. col. 4, line 66-col. 5, line 5. Place message in queue if profile is "Do Not Disturb".);

detecting a transition to said given presence state subsequent to said storing (col. 5, lines 1-6, 10-17. Change profile. End of "do not disturb."); and

performing said instant messaging operation in response to said detecting (col. 5, lines 1-6. Send message.).

21. As per claim 49, Chesnais teaches the invention as claimed including a system, comprising:

a computer system (col. 4, lines 19-21; col. 6, lines 31-34. System to direct messages.

Computing is essential to operating the system.);

an instant messenger software module configured to execute on said computer system (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. Software is essential to perform instant messaging.);

wherein said instant messenger software module is further configured to:

storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. col. 4, line 66-col. 5, line 5. Place message in queue if profile is "Do Not Disturb".);

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detecting a transition to said given presence state subsequent to said storing (col. 5, lines 1-6, 10-17. Change profile. End of “do not disturb.”); and performing said instant messaging operation in response to said detecting (col. 5, lines 1-6. Send message.).

22. As per claims 2, 21, and 40, Chesnais teaches the invention as recited in claims 1, 20, 39, wherein said instant messaging operation comprises a chat operation (col. 3, lines 51-54; col. 5, lines 1-4; col. 6, lines 44-48. Instant messaging.).

23. As per claims 3, 22, and 41, Chesnais teaches the invention as recited in claims 1, 20, 39, wherein said instant messaging operation comprises an alert operation (col. 3, lines 51-54; col. 5, lines 1-4; col. 6, lines 44-48. Instant messaging. It is inherent that a user is alerted when the instant message is received.).

24. As per claim 9, 18, 28, 37, 47, and 56, Chesnais teaches the invention as recited in claims 1, 18, 20, 30, 39, and 49, further comprising:

storing schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time (col. 4, lines 56-61; col. 5, lines 1-6.

User schedule. 9am-5pm, user will be at “work”.);

querying said schedule information (col. 4, lines 23-29, 56-61. User schedule within database. col. 5, lines 1-6, 35-40, 55-57. Profile structure around schedule. Message processed based on profile. It is inherent that the schedule is accessed to determine profile.); and

if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence

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state each correspond to said given user (col. 5, lines 55-59. Profile changed to profile indicated by schedule.).

25. As per claims 10, 29, and 48, Chesnais teaches the invention as recited in claims 1, 20, and 39, further comprising:

storing an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to said given user (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. col. 4, line 66-col. 5, line 5. Place message in queue if profile is "Do Not Disturb".);

detecting a transition to said given presence state subsequent to said storing (col. 5, lines 1-6, 10-17. Change profile. End of "do not disturb."); and

performing said instant messaging operation in response to said detecting (col. 5, lines 1-6. Send message after change in profile.).

26. As per claims 12, 31, and 50, Chesnais teaches the invention as recited in claims 11, 30, and 49, wherein said instant messaging operation comprises a chat operation (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. col. 5, lines 1-2. Messages.).

27. As per claims 13, 32, and 51, Chesnais teaches the invention as recited in claims 12, 31, and 50, wherein said given presence state is indicative of an idle user state (col. 25, lines 40-47. Transmit availability of user, whether the user is idle.), and wherein performing said instant messaging operation comprises initiating said chat operation (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging.).

28. As per claims 14, 33, and 52, Chesnais teaches the invention as recited in claims 11, 30, and 49,

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wherein said instant messaging operation comprises an alert operation (col. 3, lines 51-54; col. 5, lines 1-4; col. 6, lines 44-48. Instant messaging. It is inherent that a user is alerted when the instant message is received.).

29. As per claims 15, 34, and 53, Chesnais teaches the invention as recited in claims 14, 33, and 52, wherein said given presence state is indicative of an idle user state (col. 25, lines 40-47. Transmit availability of user, whether the user is idle.), and wherein performing said instant messaging operation comprises initiating said alert operation (col. 3, lines 51-54; col. 5, lines 1-4; col. 6, lines 44-48. Instant messaging. It is inherent that a user is alerted when the instant message is received.).

30. As per claims 19, 38, and 57, Chesnais teaches the invention as recited in claims 11, 30, and 49, further comprising:

receiving an instant messaging operation directed to said given user, wherein said given user is not offline (col. 3, lines 51-54; col. 6, lines 47-59. Instant messaging. col. 5, lines 1-2. Receive messages.);

determining a presence state of said instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user (col. 5, lines 3-4. Profile set as “do not disturb”); and

selectively processing said instant messaging operation dependent upon said presence state in response to said determining (col. 13, lines 4-6. Place message in queue.).

#### **Claim Rejections - 35 USC § 103**

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claims 4, 16, 23, 35, 42, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chesnais, in view of Cristofalo et al. US Publication #2002/0152117 (Cristofalo hereinafter).

33. As per claims 4, 16, 23, 35, 42, and 54, Chesnais does not specifically teach the invention as recited in claims 1, 11, 20, 35, 39, and 49, wherein said instant messaging operation comprises a poll operation.

34. Cristofalo teaches of providing an instant messaging operation comprising a poll operation (Paragraph 0023. Media object relates to polling question. Bi-directional communications via instant messaging. Claims 58, 60. Chat/Instant messaging interface utilizes media object. ).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the instant messaging operation as taught by Chesnais to comprise a poll operation as taught by Chesnais. The motivation for the suggested combination is that Cristofalo's teachings of providing a poll operation would enhance Chesnais' teachings by utilizing the instant messaging system to create a user profile and provide customized information to the user such as advertisements.

36. Claims 5, 7-8, 17, 24, 26-27, 36, 43, 45-46, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chesnais, in view of Horvitz et al. US Publication #2004/0143636 (Horvitz hereinafter).

37. As per claim 5, 24, and 43, Chesnais teaches the invention as recited in claims 1, 20, and 39, wherein selectively processing said instant messaging operation dependent upon said presence state

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further comprises: queuing said instant messaging operation without notifying said given user if said presence state is indicative of a user state (col. 5, lines 1-6. Queue message for later delivery.). Chesnais does not specifically teach of notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and the user state being specifically a busy user state.

38. Horvitz teaches of notifying a given user of said instant messaging operation if said presence state is indicative of an idle user state and queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state (Paragraph 0009. Busy profile. Paragraphs 0183; 0185. User sets thresholds on alerting on states of activity and inactivity. It is implied that the user may be alerted when active or inactive depending on preference.).

39. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to notify a given user of said instant messaging operation if said presence state is indicative of an idle user state and queue said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state. The motivation for the suggested combination is that Horvitz's teachings would improve Barsness' teachings by providing messages based on determined status of users, which would reduce disrupting the user when the user is associated with an activity.

40. As per claims 7, 26, and 45, Chesnais does not specifically teach the invention as recited in claims 5, 24, and 43, further comprising: detecting a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and notifying said given user of a queued instant messaging operation in response to detecting said transition.

41. Horvitz teaches of detecting a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and notifying said given user of

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a queued instant messaging operation in response to detecting said transition (Paragraph 0185. Determine idle activity following activity. Alert the user of the message.).

42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to detect a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and notify said given user of a queued instant messaging operation in response to detecting said transition. The motivation for the suggested combination is that Horvitz's teachings would improve Chesnais' teachings by providing messages based on determined status of users, which would reduce disrupting the user when the user is associated with an activity.

43. As per claims 8, 17, 27, 36, 46, and 55, Chesnais does not specifically teach invention as recited in claims 1, 11, 20, 30, 39, and 49, further comprising: detecting a computer system activity level indicative of computer system activity; determining whether said activity level exceeds an activity threshold in response to said detecting; and transitioning said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold.

44. Horvitz teaches of detecting a computer system activity level indicative of computer system activity, determining whether said activity level exceeds an activity threshold in response to said detecting; and transitioning said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold (Paragraphs 0183; 0185. Determine user activity and determine how busy the user is. Paragraph 0204. State of busy determined by observations of user activity.)

45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to detect a computer system activity level indicative of computer system activity, determine whether said activity level exceeds an activity threshold in response to said detecting;

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and transition said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold. The motivation for the suggested combination is that Horvitz's teachings would improve Chesnais' teachings by providing messages based on determined status of users, which would reduce disrupting the user when the user is associated with an activity.

46. Claims 6, 25, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chesnais and Horvitz, in view of Beyda, US Publication #2003/0229722 (Beyda hereinafter).

47. As per claims 6, 25, and 44, Chesnais and Horvitz teach the invention as recited in claims 5, 24, and 43, wherein said instant messaging operation is a chat operation initiated by a second user (col. 12, lines 61-56. Instant message for another user.), and queuing said instant messaging operation without notifying said given user. Chesnais and Horvitz do not specifically teach the method further comprises notifying said second user of said queuing.

48. Beyda teaches a system for processing instant messages, wherein a sender is notified of a queued instant message (Paragraphs 0043; 0048. Notification sent to the sender that the instant message has been stored.).

49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to notify the sender of a queued instant message. The motivation for the suggested combination is that Horvitz's teachings would improve the user-friendliness of the suggested system by informing status of messages to the senders.

### **Conclusion**

50. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

52. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

53. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. J./  
Examiner, Art Unit 2154

/Nathan J. Flynn/  
Supervisory Patent Examiner, Art Unit 2154